

REMARKS

This paper is filed responsive to the Office Action mailed March 31, 2009. Claims 1-25 are pending. Applicants have amended claims 1-15 to more clearly define the invention and conform the claims to a U.S. claiming style. Claims 16-25 are new. No new matter has been added.

The Examiner indicates that the information disclosure statement filed January 17, 2006, fails to comply with the provisions of CFR 1.97, 1.98 and MPEP § 609 because Applicants failed to supply reference dates for the cited art. Applicants have with this Amendment resubmitted the information disclosure statement with reference dates.

The Examiner objected to the length of the abstract. Applicant has amended the Abstract to be more concise, and seeks withdrawal of the objection.

The Examiner objected to the drawings under 37 CFR 1.83(a), which states that drawings must show every feature of the invention specified in the claims. In particular, the Examiner objects to the lack of a drawing that depicts the threaded shaft feature described in claim 11. Applicants have amended claim 11 to omit the threaded shaft feature, and thus seek withdrawal of the objection.

Claims 1-10 and 13-15 stand rejected under 35 U.S.C. 102(b) as being anticipated by Sonnabend et al. (WO 01/34040). Applicants traverse the rejection.

As amended, claim 1 claims a bone resection device for use in resection of bone during joint replacement surgery that includes a handle; an elongate shaft rotatably mounted to the handle, the shaft having a shaft axis, a proximal end and a distal end; a cutting tool housing attached to the shaft at or towards the distal end of the shaft; at least one cutting tool fastened to the housing, the at least one cutting tool configured to be movable between a retracted position and an extended position; and a pivot control member having a proximal end and a distal end, the pivot control member configured to be at least partially disposed about the elongate shaft, the

pivot control member being attached at or toward the distal end of the pivot control member to the at least one cutting tool, *the distal end of the pivot control member and the distal end of the shaft being configured to be axially displaceable with respect to one another a predetermined distance, during operation of the device.*

Sonnabend does not describe the invention claimed in claim 1. In particular, Sonnabend fails to describe the claimed pivot control member, the distal end of which together with the distal end of the shaft are configured to be axially displaceable with respect to one another a predetermined distance, during operation of the device. In contrast, the cam retaining unit 6 of Sonnabend, which the Examiner offers as the pivot control member, and the distal end of the shaft are not axially displaceable with respect to one another. As a result, Applicants submit that claim 1 is patentable over Sonnabend, and request that the Examiner withdraw the rejection.

Applicants further submit that many of the dependent claim elements also are not described in Sonnabend. For example, claim 5 depends from claim 1, and more narrowly claims that the distal end of the pivot control member is configured to be axially displaceable with respect to the distal end of the shaft a predetermined distance, during operation of the device. Claim 6 depends from claim 5 and further defines that the device includes a cam follower, and wherein one of the pivot control member and the shaft comprises a cam surface configured to accept the cam follower, the cam surface extending in a plane generally perpendicular to the shaft axis, and wherein one of the cam surface and the cam follower is fixed relative to the handle, and the other of the cam surface and the cam follower is fixed relative to the pivot control member. Claim 7 depends from 6 and further defines that the cam surface is provided on the proximal end of the pivot control member and the cam follower is fixed relative to the handle. Claim 23 depends from claim 1 and claims that the predetermined distance is defined by a cam surface located on the proximal end of the pivot control member.

Further, Applicants submit that new independent claim 24 is also patentable over Sonnabend. Claim 24 claims a bone resection device for use in resection of bone during joint replacement surgery that includes a handle; an elongate shaft rotatably mounted to the handle,

the shaft having a shaft axis, a proximal end and a distal end; a cutting tool housing attached to the shaft at or towards the distal end of the shaft, the cutting tool housing having a slot; at least one cutting tool fastened to the housing, the at least one cutting tool configured to be movable between a retracted position and an extended position, the at least one cutting tool having an elongate cam track formed therein; and a pivot control member having a proximal end and a distal end, the pivot control member comprising a follower extending generally perpendicular from the distal end thereof and configured to extend through the slot and engage with the cam track of the at least one cutting tool, the pivot control member configured to be at least partially disposed about the elongate shaft, the pivot control member being attached at or toward the distal end of the pivot control member to the at least one cutting tool.

Claims 11-12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sonnabend et al. (WO 01/34040) in view of Kuslich et al. (US 6,383,188). Applicants traverse this rejection. Amended claims 11 and 12 depend ultimately from independent claim 1 and are patentable at least for the reasons cited above. As a result, Applicants request that the rejection be withdrawn.

Please charge any required fee in connection with the prosecution of this application to Deposit Account No. 10-0750.

Respectfully submitted,

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